

REMARKS

Summary

Claims 1-4, 7-10, 13-15, 17-20, 22-25, 43-45, 48, and 50-52 are pending. Claims 26-32, 35-42, 53-55, and 58-60 have been previously withdrawn. Claims 1 and 43 are amended herein. No new matter is added.

Allowable Claims

Applicants thank the examiner for the indication that claim 50 would be allowable if rewritten in independent form.

Rejections Under 35 USC 112

Claims 1-4, 7-10, 13-15, 17-20, and 22-25 are rejected under 35 USC 112, second paragraph, as being indefinite. It is unclear whether claims 43-45, 48, and 50 are also rejected for similar reasons as such claims were listed in Paragraph 5 only. However, to expedite prosecution, claims 1 and 43 are amended herein to address the concerns raised in the Office Action. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

With respect to the alleged omitted steps, Applicants assert that the claims are complete. MPEP 2172.01 indicates that a "claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. . . . Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention." The MPEP section goes on to say that "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention."

Thus, the rejection appears to be a blend of the two issues raised in MPEP 2172.01, as the rejection alleges improper missing elements under 35 USC 112, second paragraph. However, Applicants assert that under either the first or second

paragraphs of 35 USC 112, the claims are sufficiently enabled, clear, and distinctly claim the invention. The interrelation among the features of the claims has been clarified. In addition, there are no “necessary elements” described in the specification or made of record that are absent from the independent claims. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejections Under 35 USC 101

Claims 1-4, 7-10, 13-15, 17-20, and 22-25 are rejected under 35 USC 101 as being directed to non-statutory subject matter. To expedite prosecution, claims 1 and 43 are amended herein to address the concerns raised in the Office Action. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejections Under 35 USC 103(a)

Claims 1-4, 7-10, 13, 14, 20, 25, 43-45, 48, 49, 51, and 52 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,636,833 to Flitcroft (Flitcroft) in view of PR Newswire article CITIBANK AND FIRST CITY BANCORPORATION OF TEXAS IN MERCHANT CREDIT CARD PROCESSING AGREEMENT, July 19, 1990 (Citibank). Applicants respectfully traverse the rejection in light of the arguments below.

Claim 1 recites a computing device implemented method comprising operating with one or more computing devices a billing service independent of one or more billing data issuing sources; obtaining by the billing service a first and a second billing data from said one or more billing data issuing sources, the first and second billing data being separate and distinct billing data; providing by the billing service the first billing data to a user for use by said user to conduct transactions with a first web site, said billing service receiving notification of usage by said user of the first billing data from its billing data issuing source resulting from said usage by said user of the first billing data; and providing by the billing service the second billing data to said user for use by said user to conduct transactions with a second web site, said billing service receiving notification of usage by said user of the

second billing data from its billing data issuing source resulting from said usage by said user of the second billing data. In summary, claim 1 recites a billing service operating independent and distinct of one or more billing data issuing sources; obtaining billing data from the one or more billing data issuing sources; providing the billing data for use by a user to conduct transactions with a web site; and receiving notification of such use.

Flitcroft teaches a credit card system whereby limited-use credit card numbers are provided by the system to the user to screen the user's master credit card number.

The Citibank reference discloses that Citibank Card Acceptance Services (CAS) purchased certain credit card processing contracts. The Citibank reference further discloses that Citibank is the largest issuer of Visa and MasterCard in the US, and one of the largest processors of such card transactions.

However, neither Flitcroft nor Citibank teaches or suggests the independent relationship between the billing service and the billing data issuing source recited in claim 1. Neither reference teaches (a) a billing service operating independent from a billing data issuing source and obtaining billing data from the source, (b) the billing service providing that data to a user for use with a web site, and (c) the billing service receiving notification of such use from the billing data issuing source, as provided in claim 1.

Claim 1 clearly provides for a single party (a billing service) to provide services in communication with and independent from a second party (a billing data issuing source). Such a provision of services and such a relationship are not taught by the references.

Furthermore, the Office Action admits that Flitcroft fails to teach (1) that the billing service provides the billing data to the user and (2) that the billing service receives notification of use of the data from the billing data issuing source.

The Office Action, instead, cites a secondary reference – Citibank – for such teachings. The Citibank reference, however, does not provide the teachings for which it is cited, and is, further, not even an enabling reference.

The Office Action does not point to any specific teachings provided in the Citibank reference although it is cited for teaching several elements of claim 1. The Citibank reference does not disclose obtaining or providing billing data by a billing service and does not disclose any notification received by the billing service.

In addition, the Office Action indicates that it is obvious that banks provide notification of usage of credit cards to users. However, the claim recites that the billing service receives notification from the billing data issuing source and, thus, any notice to the user provided by the billing data issuing source is irrelevant to the feature of the claim. Further, Applicants assert that it would not have been obvious to combine such a notification operation to the other operations of the method of claim 1 without relying on the teaching of Applicants' specification.

As stated above, the Citibank reference is also not an enabling disclosure. It is simply a press release indicating that Citibank signed an agreement to acquire certain assets of First City Bancorporation. The Citibank reference does not teach any element of claim 1 and is not an enabling prior art reference. In addition, the Citibank reference does not even provide sufficient information to ascertain the state of the existing business practices at the time, as indicated by the Office Action.

Furthermore, the Office Action fails to provide any motivation to combine the cited references. There is merely a conclusory statement that “[i]t would have been obvious to modify Flitcroft in view of Citibank to incorporate the features discussed as above, because this would conform to the existing business practices billing data processing methods.” Thus, the Office Action fails to establish a *prima facie* case of obviousness.

A teaching or suggestion to make the combination recited in the claims must be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), or in the nature of the problem to be solved. In fact, Flitcroft and Citibank do not provide a motivation to combine and there is no indication that the problem itself suggests such a motivation to combine.

Further, rejections based on 35 USC §103(a) must have a factual basis. In *re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-178 (CCPA 1967). In making such a rejection, an examiner has the duty of supplying the requisite factual basis

and may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

The motivation stated in the Office Action is lacking in any factual basis and merely states a tenuous hindsight justification for the present invention being made. At no point does the Office Action provide any indication of where one would find such motivation. For this additional reason, claim 1 is patentable over the combination of Flitcroft and Citibank.

Since the references fail to teach or suggest, alone or in combination, all the features of claim 1, claim 1 is patentable over the cited references. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1.

Claim 43 contains similar features to that discussed above with respect to claim 1. Therefore, claim 43 is patentable over the combination of Flitcroft and Citibank for at least the reasons discussed above.

Claims 2-4, 7-10, 13, 14, 20, 25, 44-45, 48, 49, 51, and 52 are dependent, directly or indirectly, on claims 1 and 43. Thus, claims 2-4, 7-10, 13, 14, 20, 25, 44-45, 48, 49, 51, and 52 are patentable over the combination of Flitcroft and Citibank, for at least the reasons discussed above.

In addition, claims 3, 13, 14, and 45 are improperly cited in the body of the Office Action as being rejected over the combination of Flitcroft and Demoff, while such claims are identified in the introductory paragraph to the rejection as being rejected over Flitcroft and Citibank. Demoff is not relied upon in the rejection of any of the currently pending claims. Thus, the column and line numbers identified from Demoff are no longer relevant, and the rejections of claim 3, 13, 14, and 45 are improper. Furthermore, the Citibank reference fails to provide the teachings identified in claims 3, 13, 14, and 45 to be missing in Flitcroft. Thus, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 3, 13, 14, and 45 for failing to set out a proper rejection.

Claims 22-24 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,636,833 to Flitcroft (Flitcroft). Applicants respectfully traverse the rejection in light of the arguments below.

Claims 22-24 provide for the billing service disputing all notifications of usage. Flitcroft however does not teach or suggest the disputing of billing. Applicants respectfully assert that the disputing of billing by a billing service is patentably distinct from any teaching or suggestion found in Flitcroft. Official notice has been taken of the fact that users may dispute billing, however claims 22-24 specifically recite the billing service disputing notifications of usage of the provided billing data. Thus, based at least in part on this distinction, Applicants respectfully request reconsideration and withdrawal of the rejection.

Furthermore, claims 22-24 are dependent indirectly on claim 1. Thus, claims 22-24 are patentable over Flitcroft for at least the reasons discussed above with respect to claim 1.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-4, 7-10, 13-15, 17-20, 22-25, 43-45, 48, and 50-52 are in condition for allowance. Early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
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